

REMARKS

Claims 13 and 17-28 are pending in the present application after cancellation of claims 17, 29 and 30 which had been previously withdrawn from further consideration. Claims 13, 25 and 27 have been amended. In view of the foregoing amendments and the following remarks, Applicants submit that all pending claims under consideration are in allowable condition.

Allowable Subject Matter

The Examiner objected to claims 25-28 as being dependent upon a rejected base claim, but the Examiner also indicated that these claims contain subject matter that would be allowable if rewritten in independent form. In response, Applicants have amended claims 25 and 27 to be in independent form to include the features of parent claim 13 (as claim 13 stood on January 2, 2008, when the Examiner first indicated that claims 25-28 would be allowable in independent form). Accordingly, claims 25 and 27, as well dependent claims 26 and 28, are in allowable condition.

35 U.S.C. 102(e) Rejection

The Examiner rejected claims 13 and 16-24 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,284,657 (“Chooi”). Claim 16 has been canceled. Applicants submit that this rejection should be withdrawn for at least the following reasons.

To anticipate a claim under 35 U.S.C. § 102(e), a single prior art reference must identically disclose each and every claim feature. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claim feature is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily

flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Although Applicants do not agree at all with the Examiner’s interpretation of Chooi as teaching all of the features of previously pending claim 13, Applicants have amended claim 13 to incorporate the features previously recited claim 16 in order to expedite prosecution of the present application. Amended independent claim 13 recites, in relevant parts, “a silicon layer, wherein substantially the entire layer is made of silicon; and a passivating layer at least regionally and superficially deposited on the silicon layer, wherein the passivating layer has a substantially inorganic first partial layer and a substantially polymer second partial layer, and wherein the first partial layer is substantially made of an oxide layer, and wherein the first partial layer has a thickness of 1 nm to 100 nm, and wherein the first partial layer is deposited directly on the silicon layer.” Amended features of claim 13 are clearly not taught or suggested by Chooi, as explained in detail below.

To the extent the Examiner contends that “layer (12)” of Chooi is considered equivalent to the claimed “silicon layer,” Chooi clearly indicates that layer (12) is a passivating layer of silicon nitride (col. 5, l. 30-31), which means layer (12) clearly does not satisfy the limitation that “substantially the entire layer is made of silicon.” In addition, to the extent the Examiner contends that the etch-stop layer (16) of Chooi is considered equivalent to the claimed “first partial layer” of the passivating layer, Chooi clearly shows that no region of the layer (16) is “deposited directly on the silicon layer” (which claimed “silicon layer” is allegedly satisfied by the passivating layer (12) of Chooi). Accordingly, Chooi does not teach or suggest that “the first partial layer is deposited directly on the silicon layer.”

For at least the foregoing reasons, claim 13 and its pending dependent claims 17-24 are not anticipated by Chooi. Withdrawal of the anticipation rejection is requested.

Conclusion

In view of the foregoing, it is respectfully submitted that all of the presently pending claims under consideration are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

 (R. No. 36,197)

Dated: April 7, 2009

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